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10/761,616	01/20/2004	Ruguo Hu	88265-7643	3530
29157	7590	01/11/2008		
BELL, BOYD & LLOYD LLP			EXAMINER	
P.O. Box 1135			LEFF, STEVEN N	
CHICAGO, IL 60690				
			ART UNIT	PAPER NUMBER
			1794	
			NOTIFICATION DATE	DELIVERY MODE
			01/11/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

# Office Action Summary

Application No.

10/761,616

Applicant(s)

HU ET AL.

Examiner

Steven Leff

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings, specifically figures 5 and 6, are particularly difficult to distinguish reference numerals. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-8, and 10-16, are rejected under 35 U.S.C. 102(b) as being anticipated by Marek (GB 2027662).

As to claims 1-8, and 10-16 Marek teaches a coffee bag, in which the bag material is made of filter paper, and may contain water insoluble material or substance to reduce to prevent agglomeration of the coffee grains, e.g. an inert or inorganic particulate material which separates or reduces contact between the grains. The bags can also contain natural wetting agents and materials for adsorbing undesired coffee constituents, e.g. caffeine. The bag impregnating or coating materials may be pectins, agar-agar, starch syrup, carboxymethyl cellulose, and sodium salts of the latter. The coffee grains preferably have a grain size of 0.1 to 0.25 mm. (abstract)

Marek further teaches that the conventionally roasted coffee may have its flavor modified by containing coffee additives or by replacing wholly or partly the roasted coffee with coffee substitutes. (pg.1 col.1 lines 59) In addition Marek teaches "anti-agglomerating materials... act as a filler for preventing or reducing contact between the grains which may result in agglomeration. The materials are used in particulate form... in powder or ground form and are employed in a quantity sufficient to achieve the desired effects which may range from approximately .1 to 100%, preferably from 1 to 50 %" (pg. 1 col. 2 line 68-99).

Alternatively Marek teaches the use of an absorbent which may be a layer between the two porous sheets of filter membrane." (pg. 2 col. 1 lines 39-54) Although Marek does not specifically state a percentage of absorbency rate for the package, (a) it does state that the material is an absorbent, and (b) since the referenced materials meet those of the instant claims, it would be expected that the absorbent material would thus be the same, absent any clear and convincing evidence and/or arguments to the contrary.

In addition, a natural wetting agent may also be used, examples of which include saponins, (pg. 1 col. 2 line 111-112) and the coffee and anti-agglomerating materials may be formed as a pellet (pg. 2 col. 1 line 16). To prepare the beverage Marek teaches placing the coffee bag in a cup or pot with boiling water and allowing it to soak (pg.2 col. 1 lines 55-60).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marek (GB 2027662) in view of Cai (6777007).

Marek was taken as above however Marek is silent with respect to the sealing seam for interconnecting the filter paper.

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod. It is preferred that the first flavor-containing materials are water soluble materials such as milk or cocoa... and the second flavor-containing materials are insoluble materials such as coffee grounds." (col. 9 lines 61-64, col. 10 lines 1-5)

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10).

Cai teaches the use of insoluble and soluble materials within a coffee bag to be used with an extraction machine (col. 10 lines 1-9). The fact that Cai distinguished between the materials as soluble and insoluble would lead one of ordinary skill in the art to conclude that the materials are being used partly for their art recognized purpose and

applicants intended function of preventing compaction while preparing a foamy beverage. Marek teaches every limitation with regard to the specific contents of the beverage package as well as forming the coffee bag where it would be expected that the top filter and bottom filter are sealed at their respective edges in order to form the bag (title) where applicant discloses on page 6, line 11 of the specification that such an outer package configuration is typically known under the usual denomination of "filter pod" and where Cai not only teaches the filter pod of Marek (col. 1 lines 24-37) but also teaches the applicants idea of using a disc shaped surface that is pre-opened, and made of plastic (col. 5 lines 44-48).

Therefore with regard to claims 17-20, one of ordinary skill in the art would have been obvious to one of ordinary skill in the art to combine the teachings of Marek and Cai to have produced a beverage package containing soluble and insoluble materials that is used in an extraction device to make a foamy coffee beverage since Both Cai and Marek teach a beverage made from a package or bag, and where Cai further teaches the use of the package with an extraction machine for its art recognized and applicant's intended purpose of the providing a beverage pod that is sufficiently dried and drip-free right after preparing the beverage (col. 2 lines 57-68).

It is further obvious to one of ordinary skill in the art at the time of the invention by the applicant to have combine the two methods, each of which is taught by the prior art to be useful for the same purpose, in order to form a third method to be used for the very same purpose, the idea of combining them flows logically from their having been individually taught in the prior art (see MPEP 2144.06)

### ***Response to Arguments***

With respect to applicant's argument that Marek fails to teach a ratio of water-soluble material to filler material between 1:5 and 1:10, applicant is directed to page 1 column 1 lines 125-127 which teaches a water-soluble material in a quantity which is either wholly or partially thereof, and column 2 line 94 which teaches that the filler is present in an amount from .1 to 100%, as it is noted that the positive recitation of .1 to 100% of filler material in combination with the teaching of the water soluble material either wholly or partially therein, is taken to positively teach a ratio of water-soluble material to filler material between 1:5 and 1:10.

With respect to the argument that the claimed subject matter solved a problem that was long standing in the art, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

With respect to applicant's argument that the claims are drawn to a pressure resistant bed and that Marek fails to teach such. It is noted that as stated by applicant in the arguments Marek teaches "filler to prevent contact between coffee grains to prevent agglomeration," where reducing contact, is taught by Marek to avoid agglomerating or caking (page 1 col. 2 lines 70-99) which inherently reduces pressure within a package and thus Marek inherently teaches forming a pressure resistant bed.

In response to applicant's argument that Marek and Cai is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Cai is relied upon to further teach that it has been well known in the art to brew soluble substances under pressure as well as teaching the specific use of a "pod" arrangement in order to produce an infused beverage.

With regard to applicant's arguments that the "Patent Office has provided no evidence that the coffee bag of Marek is capable of withstanding the high pressure injections and extractions of fluids from a beverage extraction device or is even capable of working in this manner", these arguments are not deemed persuasive for the reasons of record which are specific to the recitation of intended use of the claimed invention. Applicant has provided no evidence or convincing arguments to support their position, other than to simply disagree with the position of the Office. Further, with respect to the recitation that the device of Marek is not "capable of working in this manner"; this statement is not a positive limitation and only requires the ability to perform this function, thus applicant's claims do not recite any components which would distinguish the claimed invention from that of the prior art.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shoshō can be reached at (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

587H  
1/7/08

  
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